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Docket No.: EL0499USNA
Response to Non-Final Action of 05 Oct 05

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REMARKS

Status of Claims

- [1] Claims 13-19 and 21-25 are pending in the application.
- [2] Claim 13 has been amended herein to clarify the invention by incorporating the elements of claim 15. Support for the claim amendment is found at least in the specification at page 6, lines 6-28; page 9, lines 10-19; page 11, line 31 to page 12, line 12; page 14, lines 25-32; page 16, lines 6-12, among other places.

Rejections

- [3] All the pending claims have been rejected under 35 U.S.C. 103(a) as unpatentable over U.S. 6,266,226 to Hayashi [hereinafter "Hayashi"] in view of U.S. 5,227,960 to Kunishi et al. [hereinafter "Kunishi"].

All Claim Elements Not Disclosed

- [4] The claims as amended recite a capacitor or a printed wiring board containing a capacitor, each element of which is not disclosed in the Hayashi-Kunishi combination. Because both references lack the element wherein one or more of the plurality of electrode portions are trimmed to achieve a target capacitance value, the combination cannot establish a *prima facie* case of obviousness, as required by MPEP §2143.03.

No Suggestion/Modification from Within the Combination

- [5] Moreover, this combination also fails to establish a *prima facie* case of obviousness under the separate criterion required by MPEP §2143.01 because neither reference individually nor the combination suggests or motivates for the undisclosed element. This is because neither reference solves or suggest the technical solution of the present invention.
- [6] The present technical problem is to create a high tolerance, that is, a small variation around a target capacitance value. The technical solution of the present invention is the trimming of one or more portions of the first electrode layer in order to disconnect a section of electrode from the capacitor, thereby lowering capacitance is lowered to a value close to or at the target value (spec, at least at page 2:30-33) and thereby achieving high tolerance.

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[7] Even though Hayashi solves a similar technical problem, its technical solution is **not at all** that of the present invention and does **not** inform, suggest or hint at the present invention. To the point, Hayashi's object is to provide a capacitor having a structure capable of increasing capacitance in areas occupied by capacitor patterns while reducing variation of capacitance value (Hayashi, col. 2:36-40). Hayashi's solution is form a capacitor with a comb-type lower electrode on a substrate, to then form a dielectric on the lower electrode and to then form a comb-type upper electrode on the dielectric (Hayashi, col.2:43-47). Reducing variation of capacitance occurs by arranging the respective element electrodes of the lower and the upper electrodes in blank areas between the respective element electrodes of the other of the lower electrode and the upper electrode. Thus, it is the overall design of the Hayashi capacitor arrangement that works to reduce capacitance. This contrasts utterly with achieving high tolerance by the **trimming of one or more portions of the first electrode layer**. Another difference is that Hayashi does not disclose foil in one of the electrodes as recited in the present invention.

[8] Kunishi does not provide the recited element and importantly, cannot suggest or motivate for it and consequently cannot rehabilitate the combination as expressing a *prima facie* rejection. Kunishi does not concern the technical problem of the present invention or provide a solution for raising capacitance while increasing reducing capacitance variation. This is because Kunishi provides a stacked electrolyte capacitor, which is a separate device rather than embedded and is manufactured differently from the present invention. This means that the Kunishi device cannot be used in high tolerance contexts because the variation in capacitance is not adjustable.

[9] Kunishi seems to have been included in the combination solely to provide a recited element missing from Hayashi without considering Kunishi's technical solution and whether, because of its very different technical problem, whether one of skill in the art would be motivated to take the Hayashi invention and combine it with the Kunishi invention. Because the Examiner has brought together references a skilled artisan would not consider combinable to disclose the present modification, the rejection is based on impermissible hindsight.

[10] This combination therefore does not and cannot set forth a *prima facie* case of obviousness. Applicants respectfully request its withdrawal.

In view of the foregoing, Applicants assert the claims are in condition for allowance and respectfully request allowance of this application.

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